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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91231364
Party	Plaintiff Vale National Training Center, Inc.
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Submission	Motion to Suspend for Civil Action
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Date	01/17/2017
Attachments	Motion to Suspend TTAB 91231364 .0209.pdf(1289028 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the matter of Trademark
Application Serial No.: 86/923,011**

For the mark: VALE INSURANCE PARTNERS

Published in the Official Gazette on: October 11, 2016

VALE NATIONAL TRAINING CENTER, INC.,

Opposer,

v.

OPPOSITION NO. 91231364

VALE INSURANCE PARTNERS LLC,

Applicant.

JOINT MOTION FOR SUSPENSION

Vale National Training Center, Inc. (“Opposer”) and Vale Insurance Partners LLC (“Applicant”) jointly move to suspend this proceeding pursuant to 37 C.F.R. § 2.117(a) and would respectfully show the Board the following:

1. On August 23, 2016, Opposer filed suit against Applicant in the United States District Court, Northern District of Texas, Dallas Division, Civil Action No. 3:16-cv-02449-D (“Litigation”). Opposer alleges trademark infringement, false designation of origin, and unfair competition by the use of Applicant’s mark. Pursuant to TBMP § 510.02(a), a copy of the Original Complaint is attached as Exhibit A.

2. The Board may suspend a proceeding when a party to the proceeding is engaged in a civil action which may have a bearing on the proceeding. *See*, 37 C.F.R. § 2.117(a). The civil action does not need to be dispositive of the proceeding to warrant suspension, it needs to only have a bearing on the issues in the proceeding. *See, New Orleans Louisiana Saints LLC v.*

Who Dat?, Inc., Opp. No. 91198708, *6 (TTAB July 22, 2011). The suspension may last until termination of the civil action. *See*, 37 C.F.R. § 2.117(a).

3. The Litigation may have a bearing on the proceeding because it involves some of the same marks that are at issue in this proceeding, and requires a determination of whether or not there is a likelihood of confusion relating to those marks. Further, in the Litigation, Opposer has requested that Applicant be enjoined from continued use of the mark VALE INSURANCE PARTNERS. *See*, *Who Dat?*, Opp. No. 91198708 at *7 (Suspension appropriate because decision by the district court to enjoin use of mark would have a bearing on the proceeding.).

Therefore, the Parties respectfully request suspension of this proceeding until a final determination of the Litigation, as well as any and all appeals.

Dated: January 17, 2017.

Respectfully submitted,

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212-836-7828 telephone

ATTORNEYS FOR APPLICANT
VALE INSURANCE PARTNERS LLC

CERTIFICATE OF SERVICE

A true and correct copy of the foregoing Joint Motion for Suspension was served upon the persons listed below in the manner indicated on January 17, 2017:

Mr. Paul C. Llewellyn
Arnold & Porter Kaye Scholer LLP
250 West 55th Street
New York, NY 10019

Via Email paul.llewellyn@apks.com

/george r. schultz/
George R. Schultz

Exhibit A

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION**

**VALE NATIONAL TRAINING CENTER,
INC.,**

Plaintiff,

V.

VALE INSURANCE PARTNERS LLC,

Defendant.

CIVIL ACTION NO. _____

JURY TRIAL DEMANDED

ORIGINAL COMPLAINT

Plaintiff, Vale National Training Center, Inc. (“Vale”), files its Original Complaint against Defendant, Vale Insurance Partners LLC (“Defendant”), and would respectfully show the Court the following:

Parties

1. Vale is a Texas corporation with a principal place of business at 2424 E. Randol Mill Road, Arlington, Texas 76011.
2. Vale Insurance Partners LLC is a limited liability company organized and existing under the laws of the State of Illinois with a principal place of business at 40 West 57th Street, Suite 1610, New York, New York 10019. Vale Insurance Partners LLC has listed its registered agent for service of process as VCorp Agent Services, Inc., 2920 W. Coyle Avenue, Chicago, Illinois 60645.

Jurisdiction and Venue

4. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331, 1338(a) and 15 U.S.C. § 1121 because this case arises under the Trademark Act of 1946, *as amended*, 15 U.S.C. § 1051 *et seq.*

5. This Court has jurisdiction over the unfair competition claim under the provisions of 28 U.S.C. § 1338(b), because this claim is joined with substantial and related claims under the trademark laws of the United States, 15 U.S.C. § 1051 *et seq.*

6. This Court has supplemental jurisdiction over the claims which arise under the laws of the State of Texas pursuant to 28 U.S.C. § 1367(a), as the claims are so related to the Federal Claims that they form part of the same case or controversy and derive from a common nucleus of operative fact.

7. Venue lies properly in this judicial district and division under the provisions of 28 U.S.C. § 1391(b) and (c) because Defendant is subject to personal jurisdiction in this district and, thus, is deemed to reside in this district and because the claims and causes of action arose through acts Defendant committed in this District and Division.

Factual Allegations

8. For many years and since long prior to the acts of Defendant which are the subject of this Complaint, Vale has offered and continues to offer the services of insurance adjustor training for all forms of property damage, casualty, OSHA claims, and worker's compensation across the United States, including in this District and Division. The services of Vale are provided in association with one or more of the trademarks, including "VALE TRAINING SOLUTIONS[®]", and "VALE NATIONAL[®]" (collectively, the "VALE Marks"), among others.

9. Vale is the owner of Federal Trademark Registration No. 3,782,029 on the Principal Register for the trademark “VALE TRAINING SOLUTIONS®” for “education services, namely, training and courses in the fields of appraising damage to automobiles, trucks, heavy equipment, mobile homes, recreational vehicles and all forms of property, casualty, workers compensation, legal liability, adjuster and agent licensing, professional development, professional designations, OSHA and healthcare” in Class 41. A copy of the registration is attached as Exhibit A. The Mark has been used continuously since its date of first use, which was at least as early as September 2008. The registration is valid and subsisting, uncanceled and unrevoked. The registration has become incontestable under 15 U.S.C. § 1065.

10. Vale is the owner of Federal Trademark Registration No. 2,255,689 on the Principal Register for the trademark “VALE NATIONAL®” and design for “education services, namely, training in the field of appraising damage to automobiles, trucks, heavy equipment, mobile homes, recreational vehicles and all forms of property” in Class 41. A copy of the registration is attached as Exhibit B. The Mark has been used continuously since its date of first use, which was at least as early as 1979. The registration is valid and subsisting, uncanceled and unrevoked. The registration has become incontestable under 15 U.S.C. § 1065.

11. Prior to the acts of Defendant complained of herein, Vale has expended a substantial amount of money, energy, time and effort in continuously advertising and promoting the VALE Marks in connection with its services. Vale continues to advertise and promote its services to the trade and the public.

12. As a result of the care and skill exercised by Vale in the conduct of its business, by extensive advertising, and through the continuous marketing of services under the VALE Marks, Vale has acquired a reputation for high quality.

13. Vale is now known in the marketplace as the exclusive source of services bearing the VALE Marks. The VALE Marks have acquired wide notoriety and symbolize the goodwill which Vale has created. Consequently, the VALE Marks constitute valuable assets of Vale. Growth and continuation of Vale's business depends in part upon the unique and distinctive nature of the VALE Marks and on the reputation and goodwill symbolized thereby.

14. Upon information and belief, Defendant has adopted and used the mark "VALE INSURANCE PARTNERS" (the "Infringing Mark") in association with insurance services including brokering, underwriting and issuing insurance policies and advising customers how to mitigate damage and casualty claims, as recently as January 2016, throughout the United States and Texas including in this District and Division. An example of advertising bearing the Infringing Mark is attached as Exhibit C.

15. At no time has Vale authorized or approved Defendant's sale, offer for sale, distribution, or advertising of services under the Infringing Mark. Vale has notified Defendant that its actions constitute trademark infringement and unfair competition. Yet, Defendant has continued to sell its services under the Infringing Mark.

Count I
Federal Trademark Infringement
(15 U.S.C. § 1114(1))

16. Vale repeats and realleges the allegations of Paragraphs 1 through 15 as if fully set forth herein.

17. Defendant has infringed the VALE Marks in violation of 15 U.S.C. § 1114(1)(a), by conducting various acts without the consent of Vale, including use in commerce of a reproduction, counterfeit, copy or colorable imitation of the VALE Marks and selling, and

offering for sale, services under the Infringing Mark which are likely to cause confusion, or to cause mistake or to deceive consumers.

18. Defendant has also infringed the VALE Marks in violation of 15 U.S.C. § 1114(1)(b), by conducting various acts without the consent of Vale, including using a reproduction, copy or colorable imitation of the VALE Marks on webpages, signs, prints, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of services in a manner likely to cause confusion, to cause mistake, or to deceive consumers.

19. On information and belief, Defendant's acts of trademark infringement are fraudulent, deliberate, willful and malicious, and have been committed with the intent to cause injury to Vale and its property rights in the VALE Marks, and to cause confusion, mistake and deception.

Count II
False Designation of Origin
(15 U.S.C. § 1125(a))

20. Vale repeats and realleges the allegations of Paragraphs 1 through 19 as if fully set forth herein.

21. For many years, and since long prior to the acts of Defendant, Vale has continuously marketed and sold services under the VALE Marks.

22. Since long prior to the acts of Defendant, Vale has expended a substantial amount of money in continuously advertising and promoting the VALE Marks in connection with its services. Vale continues to advertise and promote its services to the trade and to the public under the VALE Marks.

23. Since long prior to the acts of Defendant, Vale has acquired a fine reputation because of its uniformly high quality of services sold under the VALE Marks and because of its extensive advertising and sales. As a result, services associated with the VALE Marks have been and are now recognized by the public and the trade as originating from a single source, namely, Vale.

24. Because of the inherent distinctiveness of the VALE Marks and/or because the marks have acquired a secondary significance in the industry, the VALE Marks have come to indicate a single source, namely Vale, for its services.

25. Defendant's acts are in violation of 15 U.S.C. § 1125(a)(1)(A) because Defendant has used the Infringing Mark in commerce, in association with its services, which constitutes a false and misleading description of fact and a false or misleading representation of fact and which is likely to cause confusion, or cause mistake, or to deceive as to the affiliation, connection or association of Defendant with Vale, or as to the origin, sponsorship or approval of Defendant's services.

26. Defendant's acts are in violation of 15 U.S.C. § 1125(a)(1)(B) because Defendant has used, in connection with services, in commerce, words, terms, names, symbols and devices and combinations thereof and false, misleading descriptions of fact in commercial advertising and promotions which misrepresent the nature, characteristics, and qualities of Defendant's services and/or commercial activities.

27. On information and belief, Defendant's acts of false designation of origin are fraudulent, deliberate, willful and malicious, and have been committed with the intent to cause injury to Vale and its property rights in the VALE Marks, and to cause confusion, mistake and deception.

Count III
Injury to Business Reputation and Dilution
(Tex. Bus. & Com. Code Ann. § 16.103)

28. Vale repeats and realleges the allegations in Paragraphs 1 through 27 as if fully set forth herein.

29. Beginning at least as early as 1979, Vale adopted and used at least one of the VALE Marks in association with its services. The VALE Marks have been used by Vale or those under its supervision and authority continuously since the respective first use date of each trademark.

30. The VALE Marks are each famous and inherently distinctive and/or have acquired distinctiveness. The VALE Marks have been registered on the Principal Register of the United States Patent and Trademark Office and have been used extensively throughout the State of Texas.

31. Defendant has adopted and used a trademark in commerce that is likely to cause dilution of the distinctive quality of one or more of the VALE Marks. Specifically, the use of the Infringing Mark is likely to create confusion and induce consumers to believe that the services offered by Defendant are actually those of Vale or connected or associated with Vale. Moreover, the distinctive quality of the VALE Marks will be blurred and tarnished through the actions of Defendant. Accordingly, Defendant's conduct violates the Texas Trademark Act.

32. On information and belief, Defendant's violations of the Texas Trademark Act are fraudulent, deliberate, willful and malicious, and have been committed with the intent to cause injury to Vale and its property rights in the VALE Marks, and to cause confusion, mistake and deception.

Count IV
Unfair Competition
(Texas Common Law)

33. Vale repeats and realleges the allegations in Paragraphs 1 through 32 as if fully set forth herein.

34. Vale has adopted and used one or more of the VALE Marks for use on and in connection with its services since at least as early as 1979 and has used the marks continuously since their respective dates of first use. The VALE Marks identify Vale as a sole source of services offered by Vale and distinguishes those services from many others.

35. As a result of the care and skill exercised by Vale in the conduct of its business and particularly in the maintenance of high quality services, by its extensive advertising, and by the extensive and continuous marketing of services throughout the industry over many years, the services offered under the VALE Marks have acquired a reputation for high quality. As a result of these efforts by Vale, consumers and the industry recognize the VALE Marks to identify Vale exclusively as a source of high quality services. The VALE Marks have acquired wide notoriety and symbolize the goodwill which Vale has created by the sale of dependable and high quality services. Consequently, the VALE Marks constitute a valuable asset of Vale.

36. Subsequent to the adoption and use of the VALE Marks by Vale, Defendant began infringing the VALE Marks by advertising and selling services under a trademark that is confusingly similar to and creates the same commercial impression as one or more of the VALE Marks in Texas. Such conduct represents unfair competition and misappropriation and is designed to cause confusion and mistake and to deceive consumers into believing that Defendant's services are somehow sponsored by, or associated with Vale.

37. On information and belief, Defendant has attempted to and has passed off on the public services of Defendant as those of Vale.

38. On information and belief, Defendant's acts of false designation of origin and misappropriation are fraudulent, deliberate, willful and malicious, and have been committed with the intent to cause injury to Vale and its property rights in the VALE Marks, and to cause confusion, mistake and deception.

Allegations Of Damage

39. Vale repeats and realleges the allegations in Paragraphs 1 through 38 as if fully set forth herein.

40. Because of Defendant's actions, Vale has suffered and will continue to suffer damage to its business, reputation and goodwill and to endure a loss of sales and profits in an amount yet to be determined.

41. Because of Defendant's actions, Defendant will be unjustly enriched by profits it has made through the sale of services utilizing the Infringing Mark.

42. Unless Defendant is enjoined from its actions, Vale will suffer irreparable harm, for which there is no adequate remedy at law.

Demand For Jury Trial

43. Pursuant to Federal Rule of Civil Procedure 38(b), Vale hereby demands a jury trial.

Prayer

WHEREFORE, Vale respectfully requests:

44. That Defendant, its officers, agents, servants, employees, attorneys, confederates and all persons in active concert or participation with it, be enjoined immediately and preliminarily during the pendency of this action, and thereafter perpetually from:

A. Using the Infringing Mark, and any reproduction, counterfeit, copy or colorable imitation of any of the VALE Marks in connection with the advertising, selling or offering for sale, services that are the same, similar, or related to those offered by Vale;

B. Using the Infringing Mark, and any reproduction, counterfeit, copy or colorable imitation of the VALE Marks in any manner likely to cause confusion, to cause mistake or to deceive;

C. Selling or passing off, inducing, or enabling others to sell or pass off any services similar to, associated with, or connected with those offered by Vale;

D. Committing any acts, including, but not limited to marketing and advertising, which are likely to cause injury to Vale's business reputation and/or blur or tarnish the distinctiveness of any of the VALE Marks;

E. Committing any acts, including, but not limited to marketing and advertising, which are calculated to cause consumers to believe that Defendant's services are Vale's services in whole or in part, unless they are entirely such;

F. Otherwise competing unfairly with Vale in any manner, including, but not limited to, usage of the Infringing Mark or any other mark which is confusingly similar to the VALE Marks;

G. Destroying, altering, disposing of, concealing, tampering with or in any manner secreting any and all business records, invoices, correspondence, books of account, receipts or other documentation relating or referring in any manner to the providing, advertising,

sale or offer for sale of any services bearing the Infringing Mark or any other mark which is confusingly similar to the VALE Marks;

45. That after final hearing Defendant be required to deliver up for destruction or, alternatively, to obliterate all infringing marks on their entire inventory of infringing items, including but not limited to signs, labels, packaging, advertisements, video and audio recordings, literature, correspondence, invoices, catalogs, and electronic advertising of any kind and any other material in its possession bearing the Infringing Mark or any other mark which is confusingly similar to the VALE Marks;

46. That for the next five (5) years, upon ten (10) days notice, Vale be permitted to inspect and audit Defendant's inventory and all business records to determine compliance with the Order issued by the Court;

47. That Defendant be ordered to account and pay over to Vale all damages sustained by Vale and profits realized by Defendant by reason of Defendant's unlawful acts as alleged herein, that such profits be fully trebled as provided by law because of the willfulness of Defendant's acts;

48. That Vale be awarded prejudgment and post-judgment interest;

49. That Vale be awarded its costs and reasonable attorney's fees; and

50. That Vale have such other and further relief as the Court deems just and proper.

Dated: August 23, 2016.

Respectfully submitted,

s/George R. Schultz

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ATTORNEYS FOR PLAINTIFF

VALE NATIONAL TRAINING CENTER,
INC.

Exhibit A

United States of America

United States Patent and Trademark Office

VALE TRAINING SOLUTIONS

Reg. No. 3,782,029

Registered Apr. 27, 2010

Int. Cl.: 41

SERVICE MARK

PRINCIPAL REGISTER

VALE NATIONAL TRAINING CENTERS, INC. (TEXAS CORPORATION)
2424 E RANDOL MILL ROAD
ARLINGTON, TX 76011

FOR: EDUCATION SERVICES, NAMELY, TRAINING AND COURSES IN THE FIELDS OF APPRAISING DAMAGE TO AUTOMOBILES, TRUCKS, HEAVY EQUIPMENT, MOBILE HOMES, RECREATIONAL VEHICLES AND ALL FORMS OF PROPERTY, CASUALTY, WORKERS COMPENSATION, LEGAL LIABILITY, ADJUSTER AND AGENT LICENSING, PROFESSIONAL DEVELOPMENT, PROFESSIONAL DESIGNATIONS, OSHA AND HEALTHCARE, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 9-0-2008; IN COMMERCE 9-0-2008.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TRAINING SOLUTIONS", APART FROM THE MARK AS SHOWN.

SN 77-558,795, FILED 8-29-2008.

TRACY CROSS, EXAMINING ATTORNEY



David J. Kyfos

Director of the United States Patent and Trademark Office

Exhibit B

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

Reg. No. 2,255,689

United States Patent and Trademark Office

Registered June 22, 1999

**SERVICE MARK
PRINCIPAL REGISTER**



VALE NATIONAL TRAINING CENTERS, INC.
(TEXAS CORPORATION)
P.O. BOX 6030
TYLER, TX 75711

FOR: EDUCATION SERVICES, NAMELY,
TRAINING IN THE FIELD OF APPRAISING
DAMAGE TO AUTOMOBILES, TRUCKS,
HEAVY EQUIPMENT, MOBILE HOMES, REC-
REATIONAL VEHICLES AND ALL FORMS OF
PROPERTY, IN CLASS 41 (U.S. CLS. 100, 101
AND 107).

FIRST USE 0-0-1979; IN COMMERCE
0-0-1979.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "NATIONAL", APART FROM
THE MARK AS SHOWN.

SER. NO. 75-502,876, FILED 6-15-1998.

SUSAN LESLIE DUBOIS, EXAMINING ATTOR-
NEY

Exhibit C

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Our Company

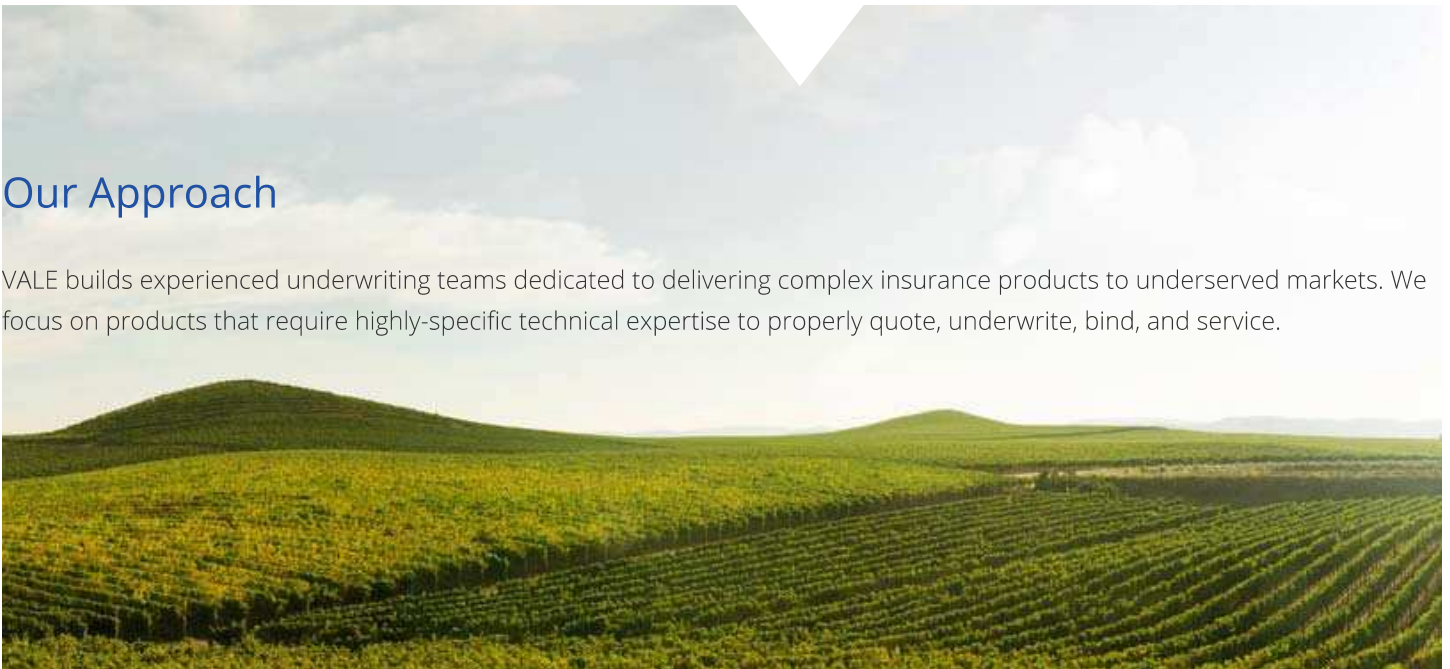
VALE Insurance Partners (VALE) is a managing general agency that focuses on writing specialty property & casualty insurance and placing the risk with sponsoring insurance carriers. We help insurers by providing the technical expertise needed to access unique and specialized markets in a safe and cost-effective manner.

VALE, in conjunction with highly-rated insurance carriers, delivers superior service to brokers and clients needing effective solutions to complex risks.

Our underwriting team has the authority to quote, bind, and manage complex insurance products on behalf of our insurance partners.

Our Approach

VALE builds experienced underwriting teams dedicated to delivering complex insurance products to underserved markets. We focus on products that require highly-specific technical expertise to properly quote, underwrite, bind, and service.



Our Value

Transactional Liability

The VALE team has deep experience as both advisors and principals in the mergers & acquisitions process which enables us to



We have built a best-in-class underwriting team that is dedicated exclusively to providing our transactional insurance products (i.e. [Rep & Warranty](#)). Our underwriters deliver three key advantages:

1. The experience and expertise to understand the unique challenges presented by complex M&A deals.
2. An efficient process that minimizes the distraction and time away from executing the underlying transaction.
3. A commitment to crafting a precise solution with clarity and transparency.

Transportation

We leverage a unique business model in order to offer our commercial auto customers a custom and affordable insurance solution. VALE employs:

1. Underwriters with an extraordinary amount of experience in the commercial automotive insurance industry.
2. Loss-mitigating strategies, such as the usage of cameras to promote safe driving and record potential incidences.
3. The ability to develop innovative solutions for our customers to help them compete in difficult markets.

[Meet Our Executive Team](#)

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